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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,458	10/30/2003	Sid Jacobi	14325US02	7987
23446	7590	12/10/2004	EXAMINER	
MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661			NGUYEN BA, HOANG VU A	
			ART UNIT	PAPER NUMBER
			2122	

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,458

Applicant(s)

JACOBI ET AL.

Examiner

Hoang-Vu A Nguyen-Ba

Art Unit

2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 05/10/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the application filed October 30, 2003.
2. Claims 1-35 have been examined.

Priority

3. The Office acknowledges this application's claim of priority under 35 U.S.C. Section 119(e) based on provisional application U.S. Serial No. 60/428,396, filed on November 22, 2002.

Oath/Declaration

4. The Office acknowledges receipt of the oath/declaration filed July 13, 2004. However, the declaration is defective because:
 - a. the signature of the first inventor, i.e., Sid Jacobi, is not dated; and
 - b. the acknowledgment of the duty to disclose information which is material to the examination of this application is indicated to be in accordance with 37 CFR 1.56(a) instead of 37 CFR 1.56.

Information Disclosure Statement

5. The Office acknowledges receipt of the Information Disclosure Statement filed May 10, 2004. It has been placed in the application file and the information referred to therein has been considered.

Drawings

6. The drawings filed October 30, 2003 are accepted by the Examiner.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 10-12, 14-15, 27, 30 and 32 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Lack of antecedent basis:

a. Claims 10 (line 7), 11 (line 2), 12 (line 3), 14 (line 2), 15 (line 2) recite the limitation “the at least one application software” There is insufficient antecedent basis for this limitation in the claim.

b. Claim 27 (line 8) recites the limitation “the communication layer.” There is insufficient antecedent basis for this limitation in the claim.

c. Claim 30 (lines 2, 3) recites the limitation “the at least one software application.” There is insufficient antecedent basis for this limitation in the claim.

d. Claim 32 (line 5) recites the limitation “the updated security data and access control information.” There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 19, 23-24, 25, 31 and 34-35 are rejected under 35 U.S.C § 101 because the claimed invention is directed to non-statutory subject matter.

Claim 19 merely recites a system for updating an electronic device comprising an update agent and a converter. These components are merely software components, i.e., computer programs per se. Such claimed matter, which is descriptive material *per se*, non-functional descriptive material is not statutory because it is not a physical “thing” nor a statutory process as there are no “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed aspects of the invention which permit the computer’s program’s functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the program itself is not a process, without the computer-readable medium needed to realize the computer’s functionality. In contrast, a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer program and the medium which permit the computer program’s functionality to be realized, and is thus mandatory. *Warner*, 33 F.d at 1361, 31 USPQ 2d at 1760. *In re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978). See MPEP § 2106 (IV)(B)(1)(a).

On this basis, claim 19 is rejected under 35 U.S.C. § 101.

Claims 23-24, 25, 31 and 34-35, which depend from claim 19, are also rejected under 35 U.S.C. § 101 for the same reasons.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

12. Claims 1-10, 19-27 and 35 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent Application No. 2001/0008024 A1 by Inaba.

Claims 1 and 19

Inaba discloses at least:

updating at least one of firmware and software in the electronic device using update information (see at least sections [0010], [0025-0028]); and

converting data associated with the at least one of firmware and software to a form compatible with an updated version of the at least one of firmware and software (see at least sections [0011], [0014], [0027], [0028]).

Claim 2

The rejection of base claim 1 is incorporated. Inaba does not specifically disclose *retrieving a list of names of converter utilities associated with the update information*. However, this step is deemed inherent to Inaba teachings because as can be seen in Figure 1 (and related discussion in the specification), steps 8, 9 provide information about data conversion which may also provide list of converter utilities.

Claims 3 and 22

The rejection of base claims 1 and 19 is incorporated. Inaba further discloses *storing update information in at least a portion of memory in the electronic device* (see at least Figure 1, items 7, 8 and related discussion in the specification).

Claim 4

The rejection of base claim 1 is incorporated. Inaba further discloses *communicating queries regarding availability of update information from the electronic device to a server* (see at least Figure 1, steps 2, 3, 4 and related discussion in the specification).

Claims 5 and 21

The rejection of base claims 1 and 19 is incorporated. Inaba further discloses *retrieving the update information and a list of names of converter utilities in a single retrieval operation* (see at least Figure 1, step 7 and related discussion in the specification).

Claims 6 and 23

The rejection of base claims 1 and 19 is incorporated. Inaba further discloses *wherein the at least one of firmware and software comprises a plurality of software applications, and each of the plurality of software applications is associated with a corresponding converter utility* (see at least Figure 3, item 8-1 and related discussion in the specification).

Claims 7 and 24

Rejections of base claims 1, 19 and intervening claims 6, 23 are incorporated. Inaba further discloses *wherein the update information is capable of updating a plurality of software applications in a single update event* (see at least Figure 1, step 7 and related discussion in the specification).

Claim 8

The rejection of base claims 1 and 19 is incorporated. Inaba further discloses *further comprising generating an update package reference, the update package reference at least comprising*

an update package location memory reference (see at least Figure 3, item 8-1 and related discussion in the specification); and

a list of names of converter utilities memory reference (see at least Figure 3, item 8-1 and related discussion in the specification).

Claims 9 and 26

The rejection of base claims 1 and 19 is incorporated. Inaba further discloses *determining whether one of a firmware and a software update is necessary, wherein if it is determined that an update is not necessary, then performing a reboot operation (see at least section [0026]).*

Claims 10 and 27

The rejection of base claims 1 and 19 is incorporated. Inaba further discloses *determining whether one of a firmware and a software update is necessary, wherein if it is determined that an update is necessary, then:*

retrieving data from an update package reference (see at least Figure 1, steps 5, 7 and related discussion in the specification);

verifying authenticity of the update information (see at least Figure 1, item 2 and related discussion in the specification);

updating at least one of firmware and software (see at least section [0026])
);

executing at least one converter utility associated with the at least one application software (see at least section [0028]);

communicating an update confirmation to at least one external system (see at least sections [0034], [0037]; e.g., notification); and

performing a reboot operation (see at least section [0026], e.g., start-microprocessor request).

Claim 20

The rejection of base claim 19 is incorporated. Claim 20 recites the same limitations of the combination of claims 2 and 4. Therefore, the same rejections are applied.

Claim 25

The rejection of base claim 19 is incorporated. Inaba does not specifically disclose *a placement layout table for mapping a memory location of update information, the placement layout table at least mapping an update information memory location and a list of names of converter utility memory location*. However, this table is deemed inherent to Inaba's teachings as Figure 1 shows conversion operations between items 3 and 5. Without a table as claimed, the conversion process would not be feasible.

Claim 35

The rejection of base claim 19 is incorporated. Inaba further discloses *wherein an application is updated when data associated with the application changes* (see at least section [0025]).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 11-18 and 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application No. 2001/0008024 A1 by Inaba, as applied to claims 1-10 and 19-27, in view of U.S. Patent No. 6,587,684 to Hsu et al. ("Hsu").

Claim 11

Rejections of base claim 1 and intervening claim 10 are incorporated. Inaba does not specifically disclose *wherein executing at least one converter utility associated with the at least one application software comprises retrieving and updating associated security information*. However, Hsu, in an analogous art, teaches how a digital telephone can connect to selected servers via a digital telephone network and packet data network to download selected control software associated with digital telephone services (14:9-13). Connection is established using authentication with security features (15:7-50) to prevent unauthorized use of the telephone and data networks.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Hsu's security and authentication features in Inaba because this would prevent unauthorized use of the telephone and data networks.

Claim 12

Rejections of base claim 1 and intervening claims 10, 11 are incorporated. Inaba does not specifically disclose *wherein retrieving and updating associated security information comprises retrieving an authorization related object and associating it with the at least one application software*. However, Hsu, in an analogous art, teaches how a digital telephone can connect to selected servers via a digital telephone network and packet data network to download selected control software associated with digital telephone services (14:9-13). Connection is established using authentication with security features (15:7-50) to prevent unauthorized use of the telephone and data networks.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Hsu's security and authentication features in Inaba because this would prevent unauthorized use of the telephone and data networks.

Claim 13

Rejections of base claim 1 and intervening claims 10, 11 are incorporated. Inaba does not specifically disclose:

retrieving a list of security information associated with the update information (); and installing the security information after updating the at least one of firmware and software. However, these features are deemed inherent to the teachings of Hsu since Hsu teaches how a digital telephone can connect to selected servers via a digital telephone network and packet data network to download selected control software associated with digital telephone services (14:9-13). Connection is established using authentication with security features (15:7-50) to prevent unauthorized use of the telephone and data networks.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Hsu's security and authentication features in Inaba because this would prevent unauthorized use of the telephone and data networks.

Claim 14

Rejections of base claim 1 and intervening claim 10 are incorporated. Inaba does not specifically disclose *wherein executing at least one converter utility associated with they at least one application software comprises converting security information comprising authentication and authorization information*. However, these features are deemed inherent to the teachings of Hsu since Hsu teaches how a digital telephone can connect to selected servers via a digital telephone network and packet data network to download selected control software associated with digital telephone services (14:9-13). Connection is established using authentication with security features (15:7-50) to prevent unauthorized use of the telephone and data networks.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Hsu's security and authentication features in Inaba because this would prevent unauthorized use of the telephone and data networks.

Claim 15

Rejections of base claim 1 and intervening claim 10 are incorporated. Inaba does not specifically disclose *wherein executing at least one converter utility associated with the at least one application software comprises converting subscription information*. However, these feature is deemed inherent to the teachings of Hsu since Hsu teaches how a digital telephone can connect to selected servers via a digital telephone network and packet

data network to download selected control software associated with digital telephone services (14:9-13). Connection is established using authentication with security features (15:7-50) to prevent unauthorized use of the telephone and data networks.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Hsu's teachings in Inaba because this would prevent unauthorized use of the telephone and data networks.

Claims 16 and 28

Rejections of base claims 1, 19 and intervening claims 10, 27 are incorporated. Inaba further discloses *wherein the at least one of firmware and software comprises a plurality of software applications, and the at least one converter utility comprises a plurality of converter utilities, each converter utility being associated with a corresponding application software* (see at least Figure 3, item 8-1 and related discussion in the specification).

Claims 17 and 29

Rejections of base claims 1 & 19 and intervening claims 10, 16 & 27, 28 respectively are incorporated. Inaba further discloses *wherein each of the software applications for which an update was determined to be necessary is updated in a single update event* (see at least Figure 1, step 7 and related discussion in the specification).

Claims 18 and 30

Rejections of base claims 1 & 19 and intervening claims 10, 16, 17 & 27, 28, 29 respectively are incorporated. Inaba further discloses *wherein executing at least one converter utility associated with the at least one of firmware and software further comprises converting data associated with each software application in a single conversion event* (see at least Figure 1, step 9 and related discussion in the specification).

Claim 32

The rejection of base claim 19 and intervening claims 20-21 are incorporated. Inaba does not specifically disclose *a communication layer, the communication layer communicating converter utilities, the converter utilities adapted to converting security data and access control information associated with the update information, and the communication layer also communicating information associated with the updated security data and access control information from the electronic device to a server*. However, Hsu, in an analogous art, teaches how a digital telephone can connect to selected servers via a digital telephone network and packet data network to download selected control software associated with digital telephone services (14:9-13). Connection is established using authentication with security features (15:7-50) to prevent unauthorized use of the telephone and data networks.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Hsu's security and authentication features in Inaba because this would prevent unauthorized use of the telephone and data networks.

Claim 33

The rejection of base claim 19 and intervening claims 20-21 are incorporated. Inaba further discloses *wherein a converter utility invokes downloading of update information and firmware/software update information* (see at least sections [0034-0037]).

Claim 31

The rejection of base claim 19 is incorporated. Inaba does not specifically disclose *the converter converts security data associated with the at least one of firmware and software*,

the converted security data enabling access to the updated version of the at least one of firmware and software. However, Hsu, in an analogous art, teaches how a digital telephone can connect to selected servers via a digital telephone network and packet data network to download selected control software associated with digital telephone services (14:9-13). Connection is established using authentication with security features (15:7-50) to prevent unauthorized use of the telephone and data networks.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Hsu's security and authentication features in Inaba because this would prevent unauthorized use of the telephone and data networks.

Claim 34

The rejection of base claim 19 is incorporated. Inaba does not specifically disclose *wherein security information is updated after a software/firmware update has been performed.* However, Hsu, in an analogous art, teaches how a digital telephone can connect to selected servers via a digital telephone network and packet data network to download selected control software associated with digital telephone services (14:9-13). Connection is established using authentication with security features (15:7-50) to prevent unauthorized use of the telephone and data networks.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to add to Inaba Hsu's security and authentication features that need to be changed regularly because this would prevent unauthorized use of the telephone and data networks.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The Examiner can normally be reached on Tuesday-Friday, 6:45 to 16:45.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam can be reached at (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit 2122

November 24, 2004



**ANTONY NGUYEN-BA
PRIMARY EXAMINER**